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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,892	10/26/2001	Howard E. Preissman	PX-03-2	8727
21394 7590 11/17/2008 ARTHROCARE CORPORATION 7500 Rialto Boulevard Building Two, Suite 100 Austin, TX 78735-8532				
EXAMINER				
PHILOGENE, PEDRO				
ART UNIT		PAPER NUMBER		
3733				
NOTIFICATION DATE		DELIVERY MODE		
11/17/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

intel_prop@arthrocure.com

Office Action Summary

Application No.

10/039,892

Applicant(s)

PREISSMAN, HOWARD E.

Examiner

Pedro Philogene

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 15-23, 25-27, 40-42 and 52-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 15-23, 25-27, 40-42 and 52-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/1/08, 8/29/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 15-18, 40-42, 52-54, 63-67, 69-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herold (4,189,065) in view of Baum (4,929,238).

With respect to the above claims Herold discloses a high pressure applicator for driving the delivery of a flowable material, comprising a first column (10) having inner wall, an outer wall, a first end and second end having an orifice for delivering implant material therethrough, and an intermediate section (taper in FIG.1) between the first and second ends, the first column further comprising an introduction section (upper portion at 15) commencing at the first end and adapted to hold the implant material, the introduction section having a different size than the intermediate section; as best seen in FIGS.1,5, a second column (21), the second column being drivable with respect to the first column to generate a pressure within the first column; and a handle (22) integrally attached to the second column, the introduction section is sized to facilitate purging of air trapped in the implant material; wherein the second column comprises a wall which is drivably engageable with one of the inner and outer walls; threading (20) on at least a portion of the inner wall of the first column, wherein the wall of the second column (21) is an external wall comprising threading engageable with the threading (20)

on at least a portion of the inner wall, as set forth in column 3, lines 49-50, wherein the first column comprises a removable section (17) adapted to be removed from the first column for drivingly engaging the first and second columns.

It is noted that Herold did not teach of at least one O-ring mounted to an end portion of the second column and interfacing with the inner wall of the second column; as claimed by applicant. However, in similar art, Baum provides the evidences of the use of an O-ring at the end of the second column to render the device suitable for dispensing high viscosity compositions.

Therefore, given the teaching of Baum, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Herold, as taught by Baum to render the device suitable for dispensing high viscosity compositions.

As to claims 40-42, 67-71, the applicator of the references above is capable of generating such pressures, as claimed, since the structure of Baum is fully functionally identical to the applicator as claimed.

Claims 20-23, 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herold (4,189,065) in view of Baum (4,929,238) in view of Perler (4,863,072).

With respect to the above claims, it is noted that the above combination of references teaches all the limitations, Except for a threading covering only a portion of the second column and an end portion of the second portion relatively smooth and wherein the smooth end portion comprises a reduced diameter section having an outside diameter less than an inside diameter of the threads on the inner wall, and an

enlarged section which closely fits with the substantially smooth inner wall to form pressure seal therewith; as claimed by applicant. However, in a similar art, Perler evidences the use of an applicator with such characteristics, as claimed by applicant, to allow the applicator to operate conveniently using one hand.

Therefore, given the teaching of Perler, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate those structures in the device of Herold/Baum, as taught by Perler to allow the applicator to operate conveniently using one hand.

Claims 19, 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herold (4,189,065) in view of Baum (4,929,238) in view of Phillips (4,032,118).

With respect to claims 19, 68, it is noted that the above combination teaches all the limitations, except for the at least one sealing element comprises a Teflon Wrap, as claimed by applicant. However, in a similar art, Phillips teaches a sealing means with Teflon wrap to enhance the seal between two components.

Therefore, given the teaching of Phillips, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the Teflon wrap of Phillips to enhance the seal between the first and the second columns.

Response to Amendment

Applicant's arguments, see Remarks, filed 8/1/08, with respect to the rejection(s) of claim(s) s 1-4, 15-23, 25-27, 40-42, 52-71 under 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Herold. The examiner

agrees with applicant the introduction section of Braum is not larger than the intermediate section between the first and second ends of the first column. However, in similar art, Herold discloses an applicator for delivery of pasty composition with an introduction portion that is larger than an intermediate portion (tapered portion) between the first and second ends of the first column, and part (17) of an introduction section that is (adapted to) fully capable of being removed from the first column.

Conclusion

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/
Primary Examiner, Art Unit 3733
November 8, 2008